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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,984	09/12/2003	Dinah W. Y. Sah	C045 US CIP2	9412
26168	7590	02/22/2006	EXAMINER	
FISH & RICHARDSON P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			LANDSMAN, ROBERT S	
			ART UNIT	PAPER NUMBER
			1647	
DATE MAILED: 02/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/661,984

Applicant(s)

SAH ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,8 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,8 and 11-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/27/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Formal Matters

- A. The Preliminary Amendment filed 12/22/05 has been entered.
- B. Claims 1-10 were pending. Claims 3-7 and 9-10 have been cancelled and new claims 11-21 have been added. Therefore, claims 1, 2, 8 and 11-21 are pending and are the subject of this Office Action.

2. Information Disclosure Statement

- A. The Information Disclosure Statement filed May 27, 2005 has been entered into the record. Reference ANN has been lined through since there is insufficient identifying information to identify the Deposit - such as the Database of deposit and the exact date of submission.

3. Specification

- A. The specification is objected to since the Brief description of Figure 1 should read, for example, "FIG. 1A and B are," or "FIG. 1A-B are" instead of "FIG.1 is." Similar correct should be made for FIG4A-C and 5A-C.

- B. When a sequence is presented in a drawing, regardless of the format or the manner of presentation of that sequence in the drawing, the sequence must still be included in the Sequence Listing and a sequence identifier ("SEQ ID NO:X") must be used either in the drawing or in the Brief Description of the Drawings. See MPEP ' 2422.02. In the instant application, a sequence identifier must be used for the sequences appearing in Figure 8.

Appropriate correction is required.

- C. According to 37 CFR 1.821(d) (MPEP § 2422), where the description or claims of a patent application discuss a sequence listing that is set forth in the "Sequence Listing" in accordance with paragraph (c) of this section, reference must be made to the sequence by use of the assigned identifier, in the text of the description or claims, even if the sequence is also embedded in the text of the description or claims of the patent application. Sequences appear in Tables 3 and 5, of the specification but are not identified by SEQ ID NO as required.

4. Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A. Claims 1, 2, 8 and 11-21 are rejected under 35 U.S.C. 101 because the claimed invention is not supported by a specific, substantial and credible asserted utility or a well established utility. These claims are directed to a polypeptide comprising SEQ ID NO:2. However, the invention encompassed by these claims has no apparent or disclosed patentable utility. This rejection is consistent with the current utility guidelines, published 1/5/01, 66 FR 1092. The instant application has provided a description of an isolated protein. However, the instant application does not disclose a specific and substantial biological role of this protein or its significance.

However, the instant application does not disclose the biological role of the claimed protein or its significance. Applicants disclose in the specification that the claimed receptor is believed to be a Neublastin which exhibits high affinity for GFPa3-RET (page 2 of the specification). Applicants also provide numerous examples in the specification regarding Neublastin – (Example 6: Effect of Neublastin on the survival of Rat Embryonic Dopaminergic Neurons and ChAT Activity. Example 7: Effect of Neublastin on the survival of slice cultures of pig embryonic dopaminergic ventral mesencephalic neurons. Example 8: Survival of Dorsal Root Ganglion Cells in Serum-free Medium. Example 9: In vivo effects of Neublastin on nigral dopamine neurons. Example 11: Biological Activity of a Truncated Rat Neublastin Polypeptide Comprising the Last Carboxy-terminal 102 Amino Acids).

However, it is not clear, first, what the specific and substantial utility is of the protein of the present invention with respect to its ability to bind GFPa3-RET. Second, it is not clear if the Examples discussed above are art-accepted models and, third, it is not clear if the claimed protein is, in fact, the protein used in the above Examples.

Furthermore, since the protein of the invention is not supported by a specific and substantial asserted utility or a well-established utility, pharmaceutical compositions comprising the claimed polypeptide also lack utility.

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5. Claim Rejections - 35 USC § 112, first paragraph - enablement

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

A. Claims 1, 2, 8 and 11-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to adequately teach how to use the instant invention. Specifically, since the claimed invention is not supported by a specific, substantial and credible asserted utility or a well established utility for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention.

6. Conclusion


A. No claim is allowable.

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on M-Th 10 AM – 7 PM (eastern).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Robert Landsman
Primary Examiner
Art Unit 1647